

REMARKS

Applicants appreciate the Examiner's review of the present Application and request reconsideration based on the following remarks. Claims 1-12 are pending in the present application.

Rejections Under 35 U.S.C. § 112

The Examiner rejected Claims 1-12 under 35 U.S.C. § 112 first paragraph, stating that the claims contain subject matter not described in the specification to enable one skilled in the art to make and use the invention. The Examiner states that the Specification discusses different trial and error calculations, but provides no specific series of steps to accomplish the optimizations. Applicants traverse this rejection. The specification provides enabling description for embodiments of the invention, inter alia, from page 4 line 13 to page 5 line 10; page 9 line 25 to page 14 line 9, page 15 lines 9 to 15, and the appendix which provides sample code used by an embodiment.

The Examiner has rejected Claims 1-12 under 35 U.S.C. § 112 second paragraph, stating that the claims discuss "trial and error" calculations "that can be done by computer to determine an optimum investment strategy". The Examiner further states that "there are no specific series of steps or means or systems that accomplishes the optimization discussed that would allow another to make or use the invention". Applicants traverse this rejection. The purpose of claims is not "to allow another to make or use the invention". That is the purpose of the specification. The purpose of claims is to "particularly point out and distinctly claim the subject matter which applicant regards as his invention. 35 U.S.C. § 112 second paragraph.

Applicants respectfully point out that Claim 1 clearly specifies a system (line 1), and then recites the components of that system, which the Applicants regard as their invention. Applicants respectfully assert that all the claims meet the requirements of 35 U.S.C. § 112 second paragraph.

Rejections Under 35 U.S.C. § 103

The Examiner rejected Claims 1-12 under 35 U.S.C. § 103 as been unpatentable over Aliber, by itself. Applicants traverse this rejection.

The Examiner states that Aliber discloses “all the systems, methods, and steps described in claims 1-12”. The Examiner then lists the language from Claim 1 and issues a blanket statement that except for tax considerations, Aliber discloses all the features of Claim 1. The Examiner fails to provide any indication of where in Aliber each of the features recited by Claim 1 is disclosed. Such failure to designate the particular part relied upon for each and every claim element makes it impossible for Applicants to respond to this rejection. See 37 C.F.R. §1.104(c)(2).

The Examiner states it would be obvious to include tax considerations in the teachings of Aliber. Applicants traverse this rejection. Claim 1 recites “wherein said account amount selection component determines **an amount** from said taxable and tax-free accounts in order to produce a maximal after-tax accumulation for said entity at said time horizon”. Claim 1 lines 17-19. This feature of asset allocation is not disclosed by Aliber, or an obvious variation thereof.

The Examiner has provided no explanation of how Aliber or any other reference discloses or makes obvious the features recited by Claims 2 – 12. Accordingly, Applicants respectfully request that the Examiner provide clear explanation with references to prior art that **each and every** feature recited in all the claims in support of the rejection, or withdraw the rejection and allow all claims.

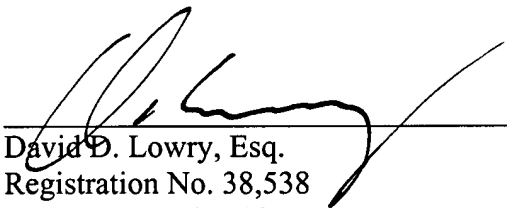
The Examiner finally states that “it would have been obvious to one skilled in the art to have used computers to optimize investment returns in a portfolio, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplish [sic] the same result involves only routine skill in the art.” Applicants respectfully

note that the Examiner is completely misstating the invention, and provides no support for this assertion in comparison to the claims. Applicants request withdrawal of this rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such action is hereby solicited. The Examiner is invited and encouraged to telephone the undersigned at the number below with any questions or concerns in furtherance of the prosecution of the present application.

Please charge any deficiency as well as any other fees which may become due at any time during the pendency of this application, or credit any overpayment of such fees to deposit account No. 50-0369. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge deposit account No. 50-0369 therefore.

Respectfully submitted,



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